71 and added new claims 208-223. Accordingly, upon entry of this Amendment, claims 1-9, 13-48, 71, 150 and 208-223 will be pending and under examination. Applicants maintain that the amendment to claim 71 and new claims 208-223 do not raise any issue of new matter and are fully supported by the specification as filed.

Support for amended claim 71 may be found inter alia in the specification, as originally-filed, on page 20, lines 9-19; page 21, lines 3-7; and page 37, lines 27-32. Support for new claim 208 may be found inter alia in the specification, as originally-filed, on page 37, lines 34-36.

Support for new claims 209-211 may be found inter alia in the specification, as originally-filed, on page 38, lines 1-9. Support for new claim 212 may be found inter alia in the specification, as originally-filed, on page 20, lines 9-19; page 21, lines 3-7; and page 38, lines 19-31. Support for new claim 213 may be found inter alia in the specification, as originally-filed, on page 38, lines 33-36.

Support for new claims 214-216 may be found inter alia in the specification, as originally-filed, on page 39, lines 1-9. Support for new claim 217 may be found inter alia in the specification, as originally-filed, on page 20, lines 9-19; page 21, lines 3-7; and page 44, line 25 through page 45, line 17. Support for new claims 218-220 may be found inter alia in the specification, as originally-filed, on page 45, lines 19-26.

Support for new claims 221-223 may be found inter alia in the specification, as originally-filed, on page 31, lines 20-23; page 32, lines 3-27; page 38, lines 11-17; page 39, lines 11-17; and page 45, lines 28-31. Accordingly, applicants respectfully request that the Amendment be entered.

Restriction Requirement Under 35 U.S.C. § 121

In the October 1, 1999 Office Action, the Examiner to whom the subject application is assigned required restriction under 35 U.S.C. § 121 to one of the following allegedly independent and distinctive inventions:

I. Claims 1-9 and 14-48, drawn to nucleic acids, vectors and host cells;

II. Claim 71, drawn to methods of identifying receptor binding compounds;

III. Claim 150, drawn to methods of modulating feeding behavior.

The Examiner advised applicant that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 C.F.R. § 1.143).

In support of the restriction requirement, the Examiner stated that the inventions listed as Groups I - III are allegedly distinct, each from the other for the following reasons: The protein product can be made by a materially different method such as its isolation from nature using various isolation and purification procedures; the DNA and protein are physically and functionally distinct product and that they are not required one for the other; the protein can be used other than in the methods specified, such as its use as a probe, to make antibodies, it could be used in various therapeutic methods, or it could be used in various diagnostic methods such as screening assay or affinity chromatography; the DNA can be used other than in the production of the protein, such as its use as a probe, it could be used in various therapeutic methods such as gene therapy or to make transgenic animals, or it could be used in various diagnostic methods such as screening assay or hybridization.

The Examiner further stated that the inventive products of Groups I and II are directed to products that are structurally, physically and functionally distinct and if determined to be patentable they would also be patentably distinct. These products are not required one for the other, nor is each of the products used in each of the methods. Additionally, the inventive methods of Groups I, II and III require the use of different steps/methods; elements/agents that are physically and functionally distinct, there are different starting elements and the final outcome/results are different for those different methods that cover various diagnostic and therapeutic methods.

In response to this restriction requirement, applicants' undersigned attorney, on behalf of applicants, hereby elect, with traverse, to prosecute the invention of Examiner's Group II, i.e. claim 71, drawn to methods of identifying receptor binding compounds. In addition applicants have hereinabove added new claims 208-223, which applicants maintain are encompassed by the elected claim of Examiner's Group II.

Applicants note that 35 U.S.C. §121 states, in part, that "[i]f two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions." [Emphasis added]. Applicants request that the restriction of Examiner's Group I from Examiner's Groups II and Examiner's Group III be withdrawn in view of the fact that the claims of Examiner's Group I are not independent of Examiner's Groups II and II. Applicants maintain that the claims of Examiner's Group I, II and III do not define patentably distinct inventions.

Under M.P.E.P. §802.01, "independent" means "there is no disclosed relationship between the subjects disclosed, that is, they are unconnected in design, operation and effect." The claims of Examiner's Group I drawn to nucleic acids, vectors and host cells

are related to the claims of Examiner's Groups II and III in that the claims in all of the groups are related to a human Ob-Re receptor. The claims of Examiner's Group I drawn to nucleic acids encoding a human Ob-Re receptor, vectors comprising these nucleic acids and host cells comprising the vectors are related to the claim of Examiner's Group II, which is drawn to a method of identifying compounds which bind human Ob-Re receptor since the claimed receptor to which these compounds bin is encoded by the claimed nucleic acids. Thus, the claims of Groups I and II are related.

The claim of Examiner's Group III, drawn to a methods of modulating feeding behavior, is related to the claims of Examiner's Group I because the method comprises administering an amount of the polypeptide of Group I which encodes the human Ob-Re receptor. Therefore, the claims of Examiner's Groups I, II, and III are related. Applicants therefore respectfully assert that two or more independent and distinct inventions have not been claimed in the subject application because the groups are not independent under M.P.E.P. §802.01. Therefore, restriction is improper under 35 U.S.C. §121.

Additionally, applicants point out that M.P.E.P. §803, the Examiner must examine the application on the merits, even though it includes claims to distinct inventions, if the search and examination of an application can be made without serious burden. There are two criteria for a proper requirement for restriction, namely (1) the invention must be independent and distinct; AND (2) there must be a serious burden on the Examiner if restriction is not required.

Applicants maintain that there would not be a serious burden on the Examiner if restriction were not required. A search of prior art with regard to Group I, a human Ob-Re receptor protein, will reveal whether any prior art exists as to the molecules which

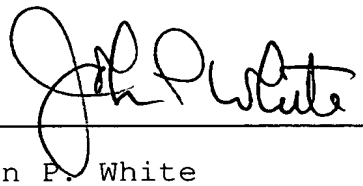
bind human Ob-Re receptor protein (Group II); and methods of modulating feeding behavior by administering human Ob-Re receptor protein (Group III). Since there is no burden on the Examiner to examine Groups I-III in the subject application, the Examiner must examine the entire application on the merits.

Applicants maintain that claims 1-9, 14-48, 71, 150, and new claims 208-223 define a single inventive concept. Accordingly, applicants respectfully requests that the Examiner reconsider and withdraw the restriction requirement and examine claims 1-9, 14-48, 71, 150, and 208-223 on the merits.

If a telephone interview would be of assistance in advancing the prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided.

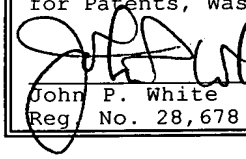
No fee, other than the enclosed $424.00, which includes the $110.00 fee for a one-month extension of time, is deemed necessary in connection with the filing of this Amendment in Response to October 1, 1999 Office Action. However, if any such fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully Submitted,



John P. White
Registration No. 28,678
Attorney for Applicants
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, New York 10036
(212) 278-0400

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.



12/1/99

John P. White Date
Reg. No. 28,678